

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Simon McGurk et al.
Title: GEL STABILIZED NANOPARTICULATE
ACTIVE AGENT COMPOSITIONS
Appl. No.: 10/659,706
Filing Date: 9/11/2003
Patent No.: N/A
Grant Date: N/A
Examiner: Eric E. Silverman
Art Unit: 1618
Confirmation 4753
Number:

REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT
UNDER 37 C.F.R. §1.705

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent.

The Patent Office determined that the patent was entitled to 238 days of PTA. Applicants believe that this PTA determination was made in accordance with the “Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)” published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, 580 F.Supp.2d 138 (D.D.C. 2008). The court determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, 580 F.Supp.2d at 141. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 578 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	764 days
(b) Total Applicant delay:	186 days
Final PTA Determination:	578 days

Applicants therefore respectfully request that the patent be accorded 578 days PTA.

The patent is not subject to a terminal disclaimer.

Payment of the requisite fee is submitted herewith. Should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

However, because this PTA error is due to a Patent Office error in interpreting and applying the PTA statute, a refund of the fee is respectfully requested.

Applicants request further that a decision on this request be **deferred or delayed** until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

Date: December 28, 2009

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Patent Term Adjustment Calculation System

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Docket Number: 029318-0968

Application Number: 10/659706

Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	09/11/2003	0		
	14 month From Application date	11/11/2004	427		
Edit Delete	Restriction Requirement	01/09/2006	851	424	
Edit Delete	Restriction Requirement Response Received at PTO	01/20/2006	862		
Edit Delete	Non-Final Office Action	04/10/2006	942		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	07/07/2006	1,030		
	3 Year Period Starts	09/11/2006	1,096		
Edit Delete	Final Office Action	10/20/2006	1,135		
Edit Delete	Final Office Action Response Received at PTO	01/08/2007	1,215		
	Final Office Action + 3 months	01/20/2007	1,227		
Edit Delete	Advisory Action	01/24/2007	1,231		
Edit Delete	Notice of Appeal Received at PTO	03/20/2007	1,286		59
Edit Delete	Request For Continued Examination (including amendment)	08/17/2007	1,436	340	
	3 Year Period Stopped	08/17/2007	1,436		
Edit Delete	Non-Final Office Action	10/19/2007	1,499		
	Non-Final Office Action + 3 months	01/19/2008	1,591		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	01/22/2008	1,594		3
Edit Delete	IDS under 1.704(c)(8) filed at PTO	04/02/2008	1,665		71
Edit Delete	Final Office Action	04/16/2008	1,679		
Edit Delete	Final Office Action Response Received at PTO	07/07/2008	1,761		
	Final Office Action + 3 months	07/16/2008	1,770		
Edit Delete	Advisory Action	07/28/2008	1,782		
Edit Delete	Notice of Appeal Received at PTO	08/06/2008	1,791		21
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Edit Delete	Non-Final Office Action	11/19/2008	1,896		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	12/16/2008	1,923		

Edit Delete	Non-Final Office Action	02/24/2009	1,993	
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	Final Office Action + 3 months	08/01/2009	2,151	
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Edit Delete	Final Office Action Response Received at PTO	09/02/2009	2,183	
Edit Delete	Notice of Allowance	10/06/2009	2,217	
	Projected Patent Grant Date	04/20/2010	2,413	
			Totals:	764
			PTA:	578
				186

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IP: 10.14.44.154

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